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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/609,073	06/30/2000	CONNIE T MARSHALL	ODS-9	2964

1473 7590 06/04/2003
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NEW YORK, NY 10020-1105

EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No. 09/609,073	Applicant(s) MARSHALL ET AL.	
	Examiner Steven Ashburn	Art Unit 3714	

All participants (applicant, applicant's representative, PTO personnel):

(1) Steven Ashburn. (3) _____.

(2) James Leiz. (4) _____.

Date of Interview: 6/2/03, 6/03/03.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____.

Claim(s) discussed: 1.

Identification of prior art discussed: US 6,004,211, US 5,830,068.

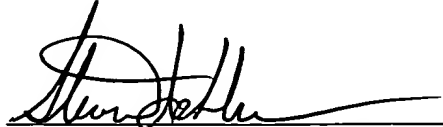
Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


 Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant called regarding the Advisory Action dated May 22, 2003 (paper no. 16). The applicant argued that US 5,830,068 qualifies as prior art under USC 102(a), not 102(e). As a result, the final rejection failed to reject the claims under 103(a). The examiner responded that the reference qualified under both portions of the code. However, in accordance with PTO policy, classification as 102(e) art was proper because 102(a) rejections are generally applied where the art is a foreign publication or a US Patent with a foreign priority date. In response the applicant stated that, because the reference also qualified under 102(a), USC 103(c) requires the examiner to reject the application under 103(a) because it was not prior art "only" under 102(e), (f) or (g). The examiner concurred, however he stated that a rejection for Obvious-type Double Patenting was still proper. The applicant disagreed. Instead, he stated that if the claims were obvious in view of the '068 patent, then the rejection could not be cured by a terminal disclaimer in any case. Subsequently, the examiner and applicant referenced the MPEP p. 800-16 which provides a flow chart for cases in which there are conflicting claims for an application and a patent. The applicant confirmed that the '068 patent and the application were commonly assigned at the time of the application. Based on the flow chart the examiner stated that the claims should be rejected under both Obvious-type Double Patenting and USC 102(e)/103(a). The applicant contended that the flow chart does not cover the current situation. The examiner stated that he would seek further direction and contact the applicant. The applicant noted that his deadline was approaching and asked for assurance that the examiner would respond quickly. The examiner agreed to respond as soon as possible.

After further consultation with Special Programs Examiner, Steve Marcus and Supervisory Patent Examiner, Tom Hughes, the examiner contacted the applicant and stated the following:

- 1) Brenner '068 qualifies as prior art under USC 102(a) because it was published before the date of the invention. As a result, the claims should have been rejected under both Obvious-type Double Patenting and USC 103(a).
- 2) Brenner '211 qualifies under prior art under USC 102(e) because it was published after the date of the invention. As a result, the claims should be rejected under Obvious-type Double Patenting. However, it could not be applied under not USC 103(a) because 103(c) removes Brenner '211 as prior art due to common ownership at the time of the invention.

Consequently, the examiners final rejection dated Dec. 11, 2002 (paper no. 13) was incomplete because it failed to reject the applicant's claims under 103(a) in view of Brenner '068. The examiner will issue a notice withdrawing finality and issue a non-final rejection in accordance with the above. The examiner reminded the applicant the he is still required to respond to the Advisory Action within the set period in order to avoid abandonment..